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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,984	09/26/2001	Philip Sicola	R255-DB	2964

7590

01/05/2004

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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,984

Applicant(s)

SICOLA, PHILIP

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, Species A in Paper No. 3 is acknowledged.
2. Claims 16-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species A2 and Group II there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 7, 10, 24, 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 6, 23, 25 and recite that the bottom surface of the second end of the lamination support members is disposed on the horizontal surface, while the dependent claims 2, 7, 24, 26 recite that the bottom surface of the lamination supports are disposed on the first and second die boards. There is no disclosure in the Specification of the bottom surface of the second end of the lamination support members being disposed on the horizontal surface and the second die board.

5. Claims 2, 7, 10, 24, 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As discussed above, there is no disclosure in the Specification and it is unclear how one of ordinary skill in the art could provide an apparatus with a bottom surface of the second end of the lamination support members being disposed on the horizontal surface and the second die board as claimed.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 7, 10, 24, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 2, 7, 10, 24, 26 are unclear by reciting that a bottom surface of the second end of the lamination support members being disposed on the horizontal surface and the second die board. It is unclear how this is possible with the current limitations of the apparatus.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4, 6, 7, 12, 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown (US Patent No. 4,471,710).

Brown discloses an apparatus with a planar horizontal surface, a first die board disposed on the planar horizontal surface, and a plurality of lamination support members with bottom surfaces on the first curved upper surface of the first die board (see figure 6). As to the limitation that the bottom surface adjacent a second end of the lamination support members is disposed upon the horizontal surface, the apparatus in Brown is considered to be capable of this limitation when assembling the parts together, prior to the last die boards being assembled to the lamination support members. Alternatively, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to assemble the apparatus as shown in Brown by assembling the lamination support members onto the first die board member at the end of the apparatus at which point the bottom surface of the second end of the lamination support members would be disposed on the horizontal surface. Only the expected results would be attained.

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As to claims 2, 24, Brown shows a second die board with a curved upper surface and a lower surface on the horizontal surface and the bottom surfaces of the lamination support members disposed on the first and second curved upper surfaces of the first and second die boards. As to claim 4, the lamination support members are rectangular in cross section. As to claims 6 and 7, 25 and 26, the lamination support members have notches to fit over the die boards (see figure 6). As to claim 12, the first die board has an upward facing curve surface.

12. Claims 3, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Patent No. 4,471,710) as applied to claim 1, 6 above, and further in view of conventional practice.

As to claim 3 where the lamination support members are cylindrical, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide lamination support members of any desired cross section, in particular cylindrical. Only the expected results would be attained. As to claim 13, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide lamination support members of any desired cross section, including an upper curved surface in order to provide the desired mold surface, it is noted that the members form a curved surface in the apparatus. Only the expected results would be attained.

13. Claims 5, 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Patent No. 4,471,710) as applied to claims 1, 6 above, and further in view of

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Lang (US Patent No. 4,971,743), Giorgi (US Patent No. 3856,592), and/or Barnett (US Patent No. 154,576).

It is considered conventionally well known in the art to provide a resilient insulating material between a mold and the product to be molded in order to protect the product and provide a uniform pressure against the product during molding. For example, the references Lang, Giorgi, and/or Barnett all disclose providing a resilient material for insulating products during molding. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the mold apparatus as shown in Brown with an insulating material as is well known in the art and further exemplified by Lang, Giorgi, or Barnett. Only the expected results would be attained.

14. Claims 9, 10, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Patent No. 4,471,710) as applied to claims 6 above, and further in view of Vogelsang (US Patent No. 3,444,568).

It is unclear what the exact shape of the notches in Brown are, however it would have been well within the art at the time of the invention to provide the notches with a variety of well known shapes as desired for the particular application. For example, Vogelsang discloses notches with downwardly facing curves and an orifice connected to the sidewalls (see figure 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus as shown in Brown with a variety of shaped notches as are considered well known in the art and exemplified by Brown in order to provide the particular desired shape.

***Allowable Subject Matter***

15. Absent any additional prior art, Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: No prior Art was found to show or suggest an apparatus as claimed with a series of closely spaced cuts on the top surface of the lamination support members in order to permit a three-dimensional contoured configuration as claimed in the claimed environment.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Gladys J. Piazza Corcoran  
Examiner  
Art Unit 1733

GJPC